

**REMARKS**

Applicant submits this Amendment After Final in reply to the final Office Action mailed July 14, 2005.

By this Amendment, Applicant has cancelled claims 2 and 7, without prejudice or disclaimer, and amended claims 1 and 6 to include the subject matter of claims 2 and 7, respectively.

Before entry of this Amendment claims 1-14 were pending. After entry of this Amendment, claims 1, 3-6, and 8-14 are pending. Claims 1 and 6 are the sole independent claims.

On pages 2-4 the Office Action, claims 1, 2, 4 and 13 were rejected under US 103(a) as being unpatentable over U.S. Patent No. 5,630,578 to Naramore et al. ("Naramore"); claims 3, 5-10, 12, and 14 were rejected under US 103(a) as being unpatentable over Naramore in view of U.S. Patent No. 5,326,093 to Sollitt; and claim 11 was rejected under US 103(a) as being unpatentable over Naramore in view of Sollitt and further in view of U.S. Patent No. 5,752,154 to Maruyama et al. ("Maruyama"). Applicant respectfully traverses these rejections.

The final Office Action has not shown how any combination of Naramore, Sollitt, or Maruyama discloses or suggests the claimed invention. For example, independent claims 1 recites a paper handling apparatus including, among other aspects, "a coupling section for coupling to other paper handling apparatus, the coupling section being provided at a position approximately equal to the paper guide opening or the paper discharge opening in a vertical direction." In another example, independent claim 6 recites an image forming system including, among other aspects, "a coupling section for

coupling to other paper handling apparatus, the coupling section being provided at a position approximately equal to the paper guide opening or the paper discharge opening in a vertical direction.” The final Office Action has not shown how any combination of Naramore, Sollitt, or Maruyama discloses or suggests at least the aforementioned aspects of each of the respective claimed inventions.

Page 2 of the final Office Action admits that “Naramore et al. does not teach the coupling section being provided at a position for coupling to other paper handling at a position approximately equal to the paper guiding opening.” The final Office Action then goes on to assert, however, that “it would have been obvious to one of ordinary skill to modify the coupling section of Naramore et al. by positioning the coupling section at a position approximately equal to the paper guiding opening for simplicity in design of the paper handling apparatus.” This alleged motivation set forth in the final Office Action, however, is an improper conclusory statement insufficient to establish motivation, as it is neither “clear and particular,” as required by In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), nor found in the prior art, as required by In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Indeed, “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner *must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pa. App. & Inter. 1985) (emphasis added). In addition, “[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is *the duty of the examiner to explain* why the combination of the teachings is proper.” Ex Parte

Skinner, 2, U.S.P.Q.2d 1788 (Bd. Pa. App. & Inter. 1986) (emphasis added). In the present case, the final Office Action has simply stated that it would simplify the design, which Applicant asserts is not any reasoning at all. Furthermore, the final Office Action has not shown how either Maruyama or Solitt remedy at least this deficiency of Naramore.

Indeed, Applicant asserts that Naramore presents the exact problems that the aforementioned aspect may be able to solve, for example, problems set forth on page 3, line 14 to page 6, line 2 of the specification.

Specifically, Naramore discloses in Figs. 4 and 5 an apparatus which comprises a mounting hook system 40 including hooks (the upper hooks 42 and lower hooks 44) at positions in vertical direction of the apparatus. Hooks 42, 44 appear to ensure the coupling of the apparatus 10 and module unit 20.

When positions of the apparatus 10 and module unit 20 are misaligned due to convex or concave floors or the like, either one of upper or lower hooks 42, 44 takes a large load and the apparatus may be damaged. In order to prevent such damage, Naramore's apparatus requires an adjustment of the apparatuses in vertical direction. When a large number of the modules are coupled with, this adjustment becomes large burden to a user.

If, however, the coupling section is "provided at a position approximately equal to the paper guide opening or the paper discharge opening in a vertical direction," as set forth in independent claims 1 and 6, a carrying path of the paper may be surely coupled even if there is convex or concave floors. Furthermore, an adjustment of a vertical direction may not be necessary. As a result, the present invention may be successful in

facilitating the setting up and adjustment of the apparatuses, for example, when a large number of the apparatuses are coupled with each other. These advantages, however, are merely exemplary, and should not construed as explicitly necessary for the invention and/or read into the claims.

Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the Section 103(a) rejections.

Applicant further submits that claims 3-5 and 8-14 depend from one of independent claims 1 and 6, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, each of the dependent claims recite unique combinations that are neither taught nor suggested by the cited reference, and therefore each are also separately patentable.

Applicant respectfully requests that this Amendment After Final be entered by the Examiner, placing claims 1, 3-6, and 8-14 in condition for allowance. The proposed amendments of claim 1 and 6 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed as dependent claims 2 and 7, respectively. Therefore, this Amendment After Final should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final Office Action presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment After Final would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment After Final would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The final Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the final Office Action.

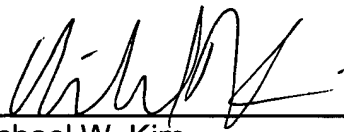
In discussing the specification and claims in this Amendment After Final, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment After Final and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 12, 2005

By:   
Michael W. Kim  
Reg. No. 51,880